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REMARKS

The current patent application has been reviewed in light of the final Office Action, dated September 25, 2006, (hereinafter "the office action"). In the office action, claims 6, 11, and 13-15 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of copending Application No. 11/153,645. Claims 6 and 13-15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicant's Admitted Prior Art (Fig. 2a in applicant's drawings, hereinafter "AAPA") in view of Almblad et al. (US 4,651,604). Claim 11 is rejected under 35 U.S.C. § 103(a) as being unpatentable over AAPA in view of Almblad as applied to claim 6, and further in view of Chen (D489,763). Entry and consideration of the above amendments and the following remarks is respectfully requested.

Claims 21-30 have been added. Support for the amendment is found, among other places, in the specification in paragraph [0037] and Fig. 3(a). No new matter is added.

Claims 6 and 13 have been amended. Assignee has amended claims to more clearly delineate intended subject matter. The amendments to the claims are made without prejudice or disclaimer, and Assignee believes that none of these claim amendments constitute narrowing amendments. In fact, some of these claim amendments are intended to be broadening amendments. Accordingly, Assignee does not intend to surrender claimed subject matter by submission of the above amendments and no prosecution history estoppel should apply.

Double Patenting

Claims 6, 11, and 13-15 have been provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of copending Application No. 11/153,645.

Without conceding the propriety of the rejections and solely to expedite allowance of the application, a terminal disclaimer is submitted herewith to obviate the provisional double patenting rejection of claims 6, 11, and 13-15.

Claim Rejections – 35 U.S.C. § 103

Claims 6 and 13-15 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicant's admitted prior art (AAPA), Fig. 2(a) in Applicant's drawings, in view of Almblad et al. (U.S. Pat. No. 4,651,604).

Assignee traverses the rejections. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations.

Assignee submits that the Examiner failed to properly establish a *prima facie* case of obviousness because (1) all of the claimed limitations are not taught or suggested by the cited references; and (2) there is no teaching or suggestion to combine or modify the references in the manner suggested by the Examiner. Accordingly, the rejection under § 103(a) is improper and should be withdrawn.

In the office action, the Examiner asserts that AAPA discloses the invention substantially as claimed "except for the handle member and the stopper being attachable and detachable with pins penetrating holes on the handle member and the stopper and corresponding holes on the transmitting shaft." The Examiner further asserts that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of AAPA to provide a detachable member as taught by Almblad in order to facilitate replacement of the member." The Examiner also noted that element 11 (the handle) of the modified device of AAPA is exchangeable between the ends. However, neither AAPA nor Almblad, alone or in combination, teaches or suggests all of the claimed limitations. That is, neither AAPA nor Almblad, alone or in combination, discloses "a stopper attachable to and detachable from a second end of said transmitting shaft capable of preventing said transmitting shaft from being dislocated... wherein said stopper and said handle member are capable of being exchangeably disposed at said first and said second ends of said transmitting shaft" as recited in claim 1. The AAPA teaches an apparatus with a distinct handle (element 11 of Fig. 2(a)) on each end of the shaft. However, contrary to the Examiner's assertion, although the handles may be identical, there is no teaching that such handles are detachable and exchangeable. Accordingly, the Examiner's rejection under § 103(a) is improper and should be withdrawn.

Not only do the cited documents fail to teach all of the relevant claim limitations, there is no teaching or motivation to combine AAPA and Almblad in the manner suggested by the Examiner. As recited in the specification on page 2, paragraph [0005], the handle and the stopper are interchangeable is so that the punching apparatus may be used by left-hand and right-hand users. In the AAPA, there is a handle at both ends so that this device may be

used by both left-hand and right-hand users. Thus, there is no need to make the handles exchangeable since left-hand users can easily use the device. Because the Examiner failed to properly establish a *prima facie* case of obviousness, the rejection under § 103(a) is improper and should be withdrawn.

Claim 11 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over AAPA in view of Almblad as applied to claim 6 above, and further in view of Chen (D489,763).

Assignee traverses the rejection. Claim 11, dependent upon claim 6, is also allowable because it depends from an allowable claim and recited further distinguishing limitations.

It is noted that claimed subject matter may be patentably distinguished from the cited documents for additional reasons; however, the foregoing is believed to be sufficient. Likewise, it is noted that the Assignee's failure to comment directly upon any of the positions asserted by the Examiner in the office action does not indicate agreement or acquiescence with those asserted positions.

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CONCLUSION

In view of the foregoing, it is respectfully asserted that all of the claims pending in the present patent application are in condition for allowance. If the Examiner has any questions, she is invited to contact the undersigned at (503) 439-6500. Entry of this amendment and reconsideration of the present patent application in view of the same, and early allowance of all the claims is respectfully requested. Please charge any underpayments or credit any overpayments to deposit account no. 50-3703.

Respectfully submitted,

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